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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/467,938 | 12/21/1999 | JOHN J. CURRO | 7897 | 2982 |

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| EXAMINER |
|---|
| BEFUMO, JENNA LEIGH |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1771 | 11 |

DATE MAILED: 03/13/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

MF-11

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/467,938 | CURRO ET AL. | |
| | Examiner | Art Unit | |
| | Jenna-Leigh Befumo | 1771 | |

*-- The MAILING DATE of this communication appears on th cover sh et with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *24 January 2002* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *10-30* is/are pending in the application.

4a) Of the above claim(s) *28-30* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *10-27* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *5,6* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election without traverse of Group I, claims 10 – 27 in Paper No. 10 is acknowledged. Claims 28 – 30 are withdrawn from consideration as being drawn to a non-elected invention.

### *Double Patenting*

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 10 – 19 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2 – 7, and 20 of copending Application No. 09/553641. Although the conflicting claims are not identical, they are not patentably distinct from each other because the scope of the claims in the current application encompasses the scope of the claims in Application No. 09/553641.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

4. Claim 19 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 20 of copending Application No.

09/553871. Although the conflicting claims are not identical, they are not patentably distinct from each other because the scope of the claims in the current application encompasses the scope of the claims in Application No. 09/553641.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 10 – 12, 14 – 21, and 23 – 27 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a first or second layer made from a nonwoven web, polymeric film, or sponge, does not reasonably provide enablement for a generic first or second extensible web as claimed. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. On pages 15 – 16 of the disclosure, the first and second webs are described as being various non-woven webs. However, the generic first and second extensible webs claimed, could be other materials such as woven or knit fabrics which are not disclosed or enabled by the specification.

7. Claims 10 – 27 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for apertures in the laminate at the bonding sites of the first and second extensible layers, does not reasonably provide enablement for a laminate having apertures randomly placed through the laminate . The specification does not enable any person

skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. The disclosure teaches, on page 9, that the apertures in the laminate are formed at the bonding sites of the first and second extensible webs when tension is applied to the web. The disclosure does not teach placing apertures in the laminates at any other locations i.e., places in the laminate where the first, second, and third web coincide.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 10 – 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. The phrase "a laminate web having a plurality of apertures" in claim 10 is indefinite. Where are the apertures formed in the laminate web? Can the apertures be any where in the web? Claim 19 is similarly rejected. Claims 11 – 18 and 20 – 27 are rejected due to their dependence on claim 10 or 19.

11. Claim 19 recites the limitation "first and second nonwoven webs" in lines 5 - 7. There is insufficient antecedent basis for this limitation in the claim. Are the first and second nonwoven webs the same as the first and second extensible webs? Claims 20 – 27 are rejected due to their dependency on claim 19. The claim is examined as if the first and second nonwoven webs are the same as the first and second extensible webs.

12. The phrase "the first and second nonwoven webs are in fluid communication via the apertures" in claim 19 is indefinite. What is meant by "fluid communication"? Have the webs

become liquid? How exactly are they in "communication"? How are the layers in contact via the apertures? Wouldn't the material of the first and second webs be in contact at the edges or perimeter of the apertures, instead of at the aperture itself, since there is not material present at the apertures? Claims 20 – 27 are rejected due to their dependence on claim 19.

13. The phrase "distinct regions that are differentiated by at least one property selected from the group of basis weight, fiber orientation, thickness, and density" in claim 19 is indefinite. What are the "distinct regions" in the laminate? Are the "distinct regions" distinct because one of the basis weight, density, fiber orientation, or thickness are different from other regions? Or are the regions "distinct" for another reason? And wouldn't the apertures qualify as "distinct regions"? The thickness, density, and weight of the laminate at the apertures would be zero. Thus, a laminate with apertures would inherently have the claimed "distinct regions". Claims 20 – 27 are rejected due to their dependence on claim 19.

***Claim Rejections - 35 USC § 102/103***

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

16. Claims 10 – 14, 17, 19 – 23, and 26 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Srinivasan et al. (5,567,501).

Srinivasan et al. discloses a thermally apertured nonwoven laminate comprising nonwoven outer layers bonded to a middle layer (abstract). The laminate comprises two outer nonwoven layers and a middle film layer (column 1, lines 60 – 65). The apertures are formed under heat and pressure causing the middle layer to bond to the outer layers and shrink away from the heat forming apertures (column 2, lines 52 – 62). The fibers of each outer layer and the middle layer become fused together and form a fused border at each aperture (column 3, lines 15 – 22). Thus, the fibers of the outer layers will inherently be in contact at the edges of the apertures, which correspond to the applicant's bond sites. Also, since the apertures are formed using heat, the bonds between the outer layers are thermal bonds. The middle layer can include various types of plastic films (column 4, lines 9 – 12), apertured plastic films (column 4, lines 43 – 45), or a nonwoven web comprising bi-component fibers (column 4, lines 52 – 60).

Although Srinivasan et al. does not explicitly teach the limitations of elongation to break, it is reasonable to presume that said limitations are inherent to the invention. Support for said presumption is found in the use of similar materials (i.e. nonwovens as the outer layers and nonwovens or films as the middle layer) and in the similar production steps (i.e. applying heat to the laminate) used to produce the apertured nonwoven laminate. The burden is upon the Applicant to prove otherwise. *In re Fitzgerald*, 205 USPQ 594. In the alternative, the claimed elongations would obviously have been provided by the process disclosed by Srinivasan et al. Note *In re Best*, 195 USPQ 433, footnote 4 (CCPA 1977) as to the providing of this rejection under 35 USC 103 in addition to the rejection made above under 35 USC 102. Thus, claims 10 – 14, 17, 19 – 23, and 26 are anticipated by Srinivasan et al.

***Allowable Subject Matter***

17. Claims 15, 16, 18, 24, 25, and 27 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims. The prior art fails to teach or suggest apertured nonwoven laminates comprising a first and second extensible webs with a third layer placed between the first and second extensible webs with the first and second joined to each other at bond sites wherein the middle layer comprises a foam, metal foil or cellulosic tissue paper layer.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jenna-Leigh Befumo whose telephone number is (703) 605-1170. The examiner can normally be reached on Monday - Friday (9:00 - 5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (703) 308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Jenna-Leigh Befumo
March 8, 2002

CHERYL A. JUSKA
PRIMARY EXAMINER